

## REMARKS

### CLAIMS 1-39

In the Office Action dated January 24, 2006, the Examiner rejected claims 1-39 under 35 U.S.C. § 102(e) based on U.S. Patent No. 6,615,189 ("*Phillips*"). For the reasons below, Applicant respectfully traverses this rejection.

In order to properly reject a claimed invention under 35 U.S.C. § 102, each and every element of the claim at issue must be found, either expressly or under principles of inherency, in a single prior-art reference. "The identical invention must be shown in as complete detail as is contained in the . . . claim[s]." See M.P.E.P. § 2131 (8th Ed. August 2005). And, "[t]he elements must be arranged as required by the claim." *Id.*

The Examiner asserts *Phillips* teaches receiving financial card distribution information from a consumer including, *inter alia*, a predetermined delivery time. (OA at 2.) In contrast, *Phillips* simply states, "[w]hen the purchase card account is complete, the card is delivered." (*Phillips m*, col. 4, lines 1-8.) Here, *Phillips*' reference to the term "[w]hen" merely indicates the sequence of events in the disclosed process for issuing a purchase card. Contrary to the Examiner's assertions, the consumer is not offered any control over the event. Further, *Phillips* does not disclose receiving from a consumer financial distribution information including a "predetermined delivery time" that is scheduled by the consumer. Further, *Phillips* also states, "[t]he place of delivery may be arranged during the initial purchase of the card or other suitable time before delivery." (*Phillips*, col. 4, lines 7-8.) Thus, although *Phillips* indicates when the delivery place may be arranged, the reference falls short of disclosing a scheduled delivery time. The examiner states "the card is delivered at a suitable time". (OA at 4.) The Examiner's

assumption is not supported by the cited art. Nowhere does the cited art disclose delivery of a card at a suitable time, as asserted. Accordingly, the rejection of claim 1 is legally deficient, and should be withdrawn.

Moreover, *Phillips* does not disclose, and the Examiner does not address, “preparing a communication to the recipient,” as recited in claim 1. Instead, the Examiner merely states that *Phillips* delivers the card to the recipient without addressing the recitation. Indeed, the cited art fails to teach or suggest this feature. For at least this additional reason, the rejection of claim is legally deficient and should be withdrawn.

Accordingly, because *Phillips* fails to teach or suggest each and every element recited in claim 1, the Examiner has not established a *prima facie* case of anticipation. Therefore, the rejection of claim 1 under 35 U.S.C. § 102(e) should be withdrawn and the claim allowed.

Claims 2-12 and 37 depend from claim 1. As explained, *Phillips* does not support the rejection of claim 1. Accordingly, the cited art also fails to support the rejection of dependent claims 2-12 and 37 for at least the same reasons set forth above in connection with claim 1. Further, the cited art fails to teach or suggest the recitations of these claims. For example, *Phillips* does not disclose providing the consumer with date selection criteria for allowing the consumer to identify the predetermined delivery time nor that the consumer may identify multiple delivery times respectively associated with multiple financial cards, as recited in claims 8 and 37. The Examiner, however, improperly suggests that “[s]ince the product (purchase card) has the expiration date (col. 3, lines 58-67), the delivery date should have enough time [until] the card expiration date.” OA at 3. Further, the Examiner concludes without support or reference

to the cited art that “[i]f multiple cards are purchased, delivery date for each card can individually [be] set.” *Id.* The cited art is silent on these features discussed by the Examiner. As such, the Examiner is improperly and unreasonably interpreting the cited art in an attempt to support the position that the cited art anticipates these claims. If the Examiner is taking Official Notice that such features are well known, Applicant notes that an Official Notice rejection is improper unless the facts asserted are well-known or common knowledge in the art, and capable of instant and unquestionable demonstration as being well-known. See M.P.E.P. § 2144.03, the procedures set forth in the Memorandum by Stephen G. Kunin, Deputy Commissioner for Patent Examination Policy dated February 21, 2002, and the precedents provided in *Dickinson v. Zurko*, 527 U.S. 150, 50 U.S.P.Q.2d 1930 (1999) and *In re Ahlert*, 424 F.2d, 1088, 1091, 165 U.S.P.Q. 418, 420 (CCPA 1970). Further, any facts asserted as well-known should serve only to “fill in the gaps” in an insubstantial manner. It is never appropriate to rely solely on “common knowledge” without evidentiary support in the record as the principal evidence upon which a rejection is based. Applicant submits that the recitations recited in at least claims 8 and 37 are not unquestionably well-known, and the Examiner has failed to demonstrate the contrary. Accordingly, Applicant traverses the Examiner’s unsupported positions set forth in the Office Action and requests that the Examiner either cite a competent prior art reference in substantiation of these conclusions, or withdraw the rejection.

Further, Applicant reminds the Examiner of the following provision set forth in M.P.E.P. § 2144.03:

[w]hen a rejection is based on facts within the personal knowledge of the examiner, the data should be stated as

specifically as possible, and the facts must be supported, when called for by the applicant, by an affidavit from the examiner. Such an affidavit is subject to contradiction or explanation by the affidavits of the applicant and other persons.

To the extent the Examiner is relying on personal knowledge that the features of claims 8 and 37 (and any other claims) are well known, Applicant requests that the Examiner provide an affidavit evidencing such knowledge as factually based and legally competent to support the Examiner's conclusions.

For these additional reasons, Applicant requests that the rejection of claims 2-12 under 35 U.S.C. § 102(e) be withdrawn and the claims allowed.

Claims 13 and 25 include recitations similar to those of claim 1. As explained, *Phillips* does not support the rejection of claim 1. Accordingly, the cited art also fails to support the rejection of independent claims 13 and 25 for at least the same reasons set forth above in connection with claim 1. Therefore, Applicant requests that the rejection of these claims be withdrawn and the claims allowed.

Claims 14-24 and 38 depend from claim 13 and claims 26-36 and 39 depend from claim 25. As explained, *Phillips* does not support the rejection of claims 13 and 25. Accordingly, the cited art also fails to support the rejection of dependent claims 14-24, 26-36, 38, and 39 for at least the same reasons set forth above in connection with claim 1. Further, claims 20, 32, 38, and 39 include recitations similar to those of claims 8 and 37. Accordingly, the cited art does not support the rejection of claims 20, 32, 38, and 39 for at least the same reasons set forth above in connection with claims 8 and 37. Therefore, Applicant requests that the rejection of these claims be withdrawn and the claims allowed.

### **CONCLUSION**

Applicant respectfully requests that this Amendment under 37 C.F.R. § 1.116 be entered by the Examiner, placing claims 1-39 in condition for allowance. Applicant submits that the proposed amendments of claims 1, 13 and 25 do not raise new issues or necessitate the undertaking of any additional search of the art by the Examiner, since all of the elements and their relationships claimed were either earlier claimed or inherent in the claims as examined. Therefore, this Amendment should allow for immediate action by the Examiner.

Furthermore, Applicant respectfully points out that the final action by the Examiner presented some new arguments as to the application of the art against Applicant's invention. It is respectfully submitted that the entering of the Amendment would allow the Applicant to reply to the final rejections and place the application in condition for allowance.

Finally, Applicant submits that the entry of the amendment would place the application in better form for appeal, should the Examiner dispute the patentability of the pending claims.

In view of the foregoing remarks, Applicant submits that this claimed invention, as amended, is neither anticipated nor rendered obvious in view of the prior art references cited against this application. Applicant therefore requests the entry of this Amendment, the Examiner's reconsideration and reexamination of the application, and the timely allowance of the pending claims.

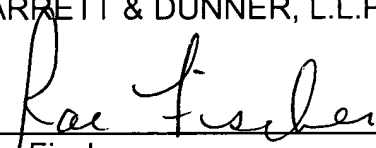
Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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GARRETT & DUNNER, L.L.P.

Dated: June 22, 2006

By: \_\_\_\_\_

  
Rae Fischer

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